

## REMARKS

In an Office Action mailed on September 15, 2004, claims 10-13, 25, 26, 28, 29, 44-48, 50 and 51 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kilgore; and claims 27 and 28 were objected to as being dependent upon rejected base claims but were indicated as being allowable if rewritten in independent form. These rejections are addressed below.

### Rejections of Claims 10-12, 25, 26, 28 and 29:

The method of independent claim 10 includes halting a flow of fluid in a well, deploying a tool from within the well while the fluid is halted, allowing the tool to freefall in the well while the fluid is halted and resuming the flow to retrieve the tool.

Contrary to the limitations of independent claim 10, Kilgore fails to address when the flow of fluid in its well is halted in relation to the deployment of the tool string 315. Thus, Kilgore neither teaches nor even suggests halting a flow of fluid and deploying a tool within the well while the fluid is halted. Furthermore, Kilgore fails to disclose or even suggest allowing a tool to freefall in a well while fluid is halted and resuming the flow to retrieve the tool.

The Examiner states that Kilgore inherently teaches halting a flow of fluid in a well to allow the tool string 315 to descend. Office Action, 2. In support of this position, the Examiner refers to the language of Kilgore that recites that well pressure is used to retrieve the tool string 315 and based on this language, concludes that a flow must be halted in order to allow the tool string 315 to descend.

However, contrary to the position taken by the Examiner, the missing claim limitations are not inherent in Kilgore, as for a missing claim limitation to be inherent in a reference, the limitation must necessarily *flow* from the reference. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). The missing claim limitation does not necessarily flow from Kilgore for at least the reason that Kilgore itself suggests alternative ways (to halting/resuming flow) to allow the tool string 315 to descend and be retrieved.

More specifically, Kilgore merely states that the well pressure is used to retrieve the tool string figure 15. Kilgore also describes, as part of the tool string 315, a surfacing mechanism to return the tool string 315 to the wellhead. Kilgore, 6:11-14. Although Kilgore does not specifically discuss the details of the "surfacing mechanism," one skilled in the art would

appreciate that one possible implementation of the surfacing mechanism would be a flowthrough valve. Thus, when the well string 315 descends, the valve is open so that less pressure acts on the well string 315, thereby allowing gravity to cause the well string 315 to descend. This is certainly consistent with Kilgore's discussion of a "gravity effect" on the tool string 315 to cause the tool string 315 to descend. Furthermore, Kilgore describes that a tool displacement mechanism 310 may be used to propel the string 315 downhole due to the lack of the gravity effect. Kilgore, 5:64-67. Thus, this is at least another mechanism for moving the tool string 315 downhole, namely, a tractor-type mechanism.

In summary, the Office Action fails to show where halting of fluid to allow the tool string 315 to descend into the well necessarily flows from Kilgore. Rather, it appears that the surfacing mechanism contained in the tool string 315 controls the pressure that acts on the tool string 315 and its relation to the gravitational force that is exerted on the tool string 315. Therefore, it is in the tool string's control whether the tool string 315 surfaces (and not in any surface valve that controls the flow through the well, for example), as Kilgore is focused on the actions that are performed by the tool string 315 itself.

Because the Office Action fails to set forth why the missing claim limitations necessarily flow from Kilgore, a *prima facie* case of anticipation has not been established for independent claim 10. As such, withdrawal of the § 102(b) rejection of claim 10 is requested.

Claims 11, 12, 25, 26, 28 and 29 are patentable for at least the reason that these claims depend from an allowable claim.

#### Rejections of Claims 44-48, 50 and 51:

Similar to claim 10, the method of independent claim 44 includes halting the flow of fluid in a well, deploying a tool from within the well while the fluid is halted, and allowing the tool to freefall in the well while the fluid is halted. Furthermore, the method of independent claim 44 recites resuming the flow to retrieve the tool.

Contrary to the limitations of independent claim 44, Kilgore fails to teach either the halting of a flow in a well to allow a tool to descend or the resuming of the flow to allow retrieval of the tool. Rather, Kilgore is vague on this point. However, several alternatives clearly exist to halting and resuming a flow. More specifically, Kilgore teaches a surfacing mechanism

that, as one skilled in the art would appreciate, may be a valve to change the forces that the pressure inside the well exert on the tool string 315. Furthermore, Kilgore teaches a tractor-type mechanism to move the tool string 315 downhole when gravity forces are not sufficient. Therefore, clear alternatives exist and demonstrate that the missing claim limitations do not necessarily flow from Kilgore. As such, withdrawal of the § 102(b) rejection of independent claim 44 is requested.

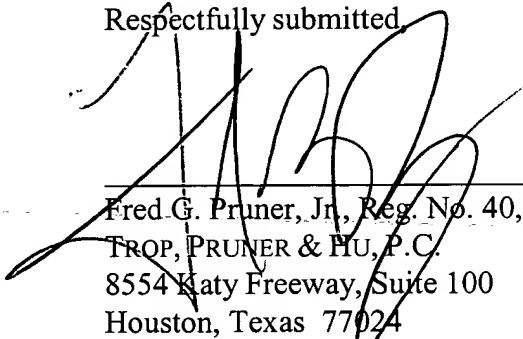
Claims 45-48, 50 and 51 are patentable for at least the reason that these claims depend from an allowable claim.

#### CONCLUSION

In view of the foregoing, withdrawal of the § 102(b) rejections and a favorable action in form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees, including extension of time fees, and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0114US).

Respectfully submitted,

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